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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/291,407 04/13/99 RICHARD

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PM82/0105

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EXAMINER

HAWKINS, J

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 01/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/291,407	Applicant(s) RICHARD ET AL.	
	Examiner Jennifer M Hawkins	Art Unit 3672	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-5,7-16 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Drawings*

- ✓ 1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the holes (14) in Figure 3 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- ↓ 3. Claims 1 and 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation added to claims 1 and 14, expanding the filter material without sliding one portion of the filter over another, is not included in the specification. However, based on the description and drawings of the filter material the limitation is permissible but further description must be added to the Specification.

Claims 3-5, 7-13, 15, 16, and 18-20 are also considered non-enabling because the claims from which they depend, claims 1 and 14, are considered non-enabling.

### ***Claim Rejections - 35 USC § 103***

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donnelly et al. in view of Arterbury et al.

Donnelly et al. discloses all the limitations of the above claims except for a removable protective cover. Arterbury et al. teaches a protective cover that can be

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dissolved inside the wellbore. It is obvious to someone of ordinary skill in the art, at the time of the invention, to form the protective cover of Donnelly et al. from a material that will be removable inside the wellbore. A protective cover is used to protect the screen as it is lowered into the borehole but an unperforated protective cover would not allow fluid to pass through the screen, defeating the purpose of the screen. Thus it would be obvious to use a protective screen that can be removed inside the wellbore as taught by Arterbury et al. allowing the screen to function once in place.

### ***Allowable Subject Matter***

5. Claims 1, 3-5, 7-16, and 18-20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action.

### ***Response to Arguments***

6. Applicant's arguments filed 13 December 2000 have been fully considered but they are not persuasive.

The corrections to Figure 3 have been considered and approved. However, Figure 3 still does not contain the reference number 14 as called for in the specification. Thus the objection to Figure 3 has been repeated.

In view of the amendment the objections to the Specification have been withdrawn, as have the 112.2 rejections to claims 5, 12, and 18.

In light of the Applicant's amendments to claims 1 and 14, the Examiner agrees that Donnelly does not teach a perforated, expandable material where the perforations are not slotted nor does Donnelly teach a filter material that can expand without one portion of the filter sliding over another. However, the later limitation must be added to the specification in order for claims 1, 3-5, 7-16, and 18-20 to be allowable over the 112.1 rejection of claims 1 and 14.

In regards to claim 2, the Applicant's argument that Arterbury does not teach a dissolvable protective cover is not considered persuasive. In column 6, lines 49-56, Arterbury teaches the use of a foil cover to protect the screen while the tool is being run into the wellbore. The foil cover is dissolvable by an acid thus removable. The foil cover taught by Arterbury is used to protect the screen from plugging while being run into the wellbore (see col. 3, lines 30-55). Claim 2 merely calls for a protective cover for the filter material, i.e. the screen, that is removable downhole; the protective cover does not necessarily have to be mounted over the filter material. Thus the rejection of claim 2 over Donnelly in view of Arterbury is repeated. This rejection can be overcome with the addition of the limitation that the protective cover is mounted over the filter material.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer M Hawkins whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday and every 2nd Friday, 6:30AM-4:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-7687 for regular communications and (703) 306-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

JMH   
January 3, 2001

  
DAVID BAGNELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600